

Oilfield Services

Schlumberger K.K.
2-2-1 Fuchinobe Sagami-hara-shi
Kanagawa-ken 229-0006 Japan
Tel: +81 42 759 5321
Fax: +81 42 759 4270

Schlumberger

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To	Commissioner Of Patents	Location	
cc		Fax	1-703-872-9306
From	Setsuko Kawashima, Intellectual Property Law Schlumberger K.K.	Date	March 17, 2005
Subject	Petition For Withdrawal Of Final Rejection	Pages (inc)	49 page(s)

Dear Sirs,

Please find the attached Petition for Withdrawal of Final Rejection.

Yours truly,


Setsuko Kawashima
IP Administrator
Intellectual Property Law
Schlumberger K.K.

Appl. No. 09/501,445
Petition Dated 17 March 2005
Responsive to Advisory Action of 8 February 2005

Attorney Docket No. 26.0178 US

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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IN RE APPLICATION OF: Cao, et al.

DOCKET NO.: 26.0178 US

MAR 17 2005

SERIAL NO.: 09/501,445

GROUP ART UNIT: 2128

FILED: February 10, 2000

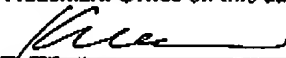
TITLE: Method of Designing
Geophysical Surveys

EXAMINER: Dr. Hugh M. Jones

Via facsimile: 1-703-872-9306

CERTIFICATE OF TRANSMISSION UNDER
37 C.F.R. 1.8

I hereby certify that this correspondence (along with any document referenced as being attached or enclosed hereto) is being facsimile transmitted to the United States Patent and Trademark Office on this date.

 March 17, 2005
Setsuko Kawashima Date

PETITION UNDER 37 CFR § 1.181
FOR WITHDRAWAL OF FINAL REJECTION AS PREMATURE

Honorable Commissioner of Patents
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 CFR § 1.181, applicants hereby petition the Director for withdrawal of a final rejection of 12 November 2004, in the above-identified application, as premature. This petition is taken from an Advisory Action of February 8, 2005, denying applicants' request to withdraw finality of the final rejection in view of the Examiner's expanded explanation in the final office action with respect to rejection of claims 1-13 under 35 U.S.C. § 112, first paragraph. An early consideration of applicants' petition is earnestly requested.

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STATEMENT OF FACTS

Claims 1-13 are pending in this application. In a first Office Action of February 25, 2004 ("First Office Action") (convenience copy as Attachment A hereto), claims 1-13 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. First Office Action at page 3. In a response of August 2, 2004 ("First Response") (convenience copy as Attachment B hereto), applicants pointed out that, in the First Office Action, the Examiner had failed to present a *prima facie* case of lack of enablement and the rejection should be withdrawn. First Response at pages 2-4.

In a second, final Office Action dated 12 November 2004 ("Final Office Action") (convenience copy as Attachment C hereto), the Examiner repeated the previous rejection under 35 U.S.C. § 112, first paragraph, and, in sections titled "Response to Arguments," provided additional arguments for rejecting the claims based on lack of enablement. Final Office Action at pages 4-6. Applicants submitted a response within two months of the Final Office Action ("Second Response") (convenience copy as attachment D hereto) requesting the Examiner withdraw the final rejection as premature in view of the Examiner's expanded explanation with respect to lack of enablement. Second Response at page 2, et seq.

In an Advisory Action of February 8, 2005 ("Advisory Action") (convenience copy as Attachment E hereto), the Examiner denied applicants' request for reconsideration. This petition under 37 CFR § 1.181 is within two months of the mailing date of the Advisory Action to request review of the Examiner's action.

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PREMATURENESS OF THE FINAL REJECTION

The First Office Action (Attachment A hereto) did not establish a reasonable basis to question the enablement provided for the claimed invention. Specifically, the First Office Action, did not “present the best case with all the relevant reasons, issues, and evidence” in support of the enablement rejection. MPEP 2164.04. In a section of the First Office Action titled “Claim Rejections – 35 USC § 112,” the Examiner merely stated:

“[t]he claimed method, including the model and its implementation do not appear to be supported by the specification. The specification appears to rely on ‘essential matter for support – the essential matter was not incorporated by reference.”

First Office Action at pages 3-4. Clearly, by not providing any specific explanation as to why the “claimed method, including the model and its implementation” is not enabled the Examiner did not carry his burden to establish a reasonable basis to question the enablement provided for the claimed invention. Id. Therefore, the Examiner failed to present a *prima facie* case for lack of enablement in the First Office Action. Moreover, by not identifying any “essential matter”, on which the Examiner contends the “specification appears to rely”, the Examiner failed to present “all the relevant reasons, issues, and evidence” in support of the lack of enablement. Id.

The Examiner relied on the Final Office Action to expand and explain the lack of enablement rejection, in part using applicants’ arguments in the First Response (Attachment B hereto). Therefore, the final rejection of the claims is premature and inappropriate. Specifically, in the Final Office Action (Attachment C hereto) the Examiner for the first time stated “the claimed invention can not be practiced without the GeoFrame teaching.” Final Office Action at page 4, et seq. Although still falling

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short of "specific technical reasons [that] are always required" to support a *prima facie* case of lack of enablement (MPEP 2164.04), the Final Office Action gave applicants some insight into the Examiner's grounds for the lack of enablement rejection of the claims.

In the Second Response (Attachment D hereto), applicants requested withdrawal of the finality of the rejection to allow applicants a full opportunity to respond to the expanded explanation in the Final Office Action. Second Response at page 2. Specifically, withdrawal of the finality of the rejection would afford applicants a full opportunity to present arguments in the present application, such as by way of an affidavit or declaration, that one skilled in the art would have been able to make and use the claimed invention using the disclosure as a guide. MPEP 716.09. Such an opportunity would allow applicants to place the present application in better form for appeal. In the Advisory Action (Attachment E hereto), the Examiner denied applicants' request.

CONCLUSION

For the foregoing reasons, the final rejection of the claims under 35 U.S.C. § 112, first paragraph, is premature. Accordingly, applicants respectfully request the Director to withdraw the finality of the rejection. An early consideration of the petition is earnestly requested.

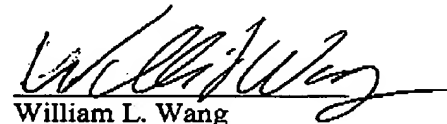
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In the event that any additional fees or credits are due owing to this petition, the Commissioner is hereby authorized to charge the amount necessary to cover any fee that may be due or to credit any overpayment to Deposit Account 50-1122.

Respectfully submitted,


William L. Wang
Registration No.: 39,871

Date: 17 March 2005
Schlumberger K.K.
2-2-1 Fuchinobe
Sagamihara-shi, Kanagawa-ken
229-0006 Japan

81-42-759-5202
81-42-759-5398(fax)
wwang@slb.com

WLW/KS